

### **REMARKS**

This is in response to the Official Action currently outstanding in the above-identified application, which Official Action the Examiner has designated as being FINAL.

Claims 1-35 were present in this application as originally filed. As a result of Applicants' election, with traverse, in response to the Examiner's Requirement for Restriction, the Examiner previously withdrew Claims 13-35 from further consideration. In response to the Response filed on 28 June 2004 in this Application, the Examiner has agreed with Applicants' assertion that Claim 13 should be included among the elected claims, but otherwise has made his Requirement for Restriction final in response to Applicants traversal thereof. Accordingly, Claims 14-35 presently stand withdrawn from further consideration pending the allowance of a generic claim, and the claims currently under active prosecution in this application are Claims 1-13.

By the foregoing Amendment, Applicants propose that Claims 1 and 2 be canceled, without prejudice. Further, Applicants propose that Claims 3, 6, 7, 12 and 13 be amended. Applicants do not propose the cancellation, addition or withdrawal of any claims by the foregoing Amendment.

The Claims of this application as they will stand in the event that the Examiner grants entry to the foregoing Amendment are set forth above as required by the Rules.

In the currently outstanding Official Action, the Examiner has:

1. Failed to re-acknowledged Applicants' claim for foreign priority under 35 USC 119 (a) – (d) or (f), and to reconfirm the receipt by the United States Patent and Trademark Office of the required certified copies of the priority document therefor;

2. Failed to reconfirm that the drawings filed with this application on 2 April 2001 have been accepted;
3. Provided Applicants with copies of the Forms PTO-1449 filed with their Information Disclosure Statement in this application duly signed, dated and initialed by the Examiner to confirm his consideration of the art listed thereon;
4. Rejected Claims 1-2 and 6-12 under 35 USC 102(b) as being anticipated by Applicants' Admitted Prior Art as shown in Figs. 6-8B and 11A-13D; and
5. Indicated that Claims 3 – 5 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims.

Further comment on items 1- 3 above is not deemed to be necessary in these Remarks in view of the Examiner's previous acknowledgement of Applicant's foreign priority claim, the receipt by the United States Patent and Trademark Office of the required certified copies of the priority documents, and his previous indication concerning the acceptability of the drawings of this application as originally filed.

With respect to items 6 and 7, the Examiner's substantive rejection of Claims 1-3 and 6-13 as being anticipated by Applicants' Admitted Prior Art as shown in Figs. 6-8B and 11A-13D of the present specification, Applicants propose that Claims 1 and 2 be canceled without prejudice, that Claim 3 be presented in independent form including all of the limitations of Claims 1 and 2, and that minor clarifying amendments be made to Claims 7, 12 and 13.

In view of the Examiner's indication that claims 3-5 and 13 would be allowable if presented in independent form including all of the limitations of their respective base claims and any intervening claims, and also in view of the above-proposed amendment to claim 6 making claim 6 dependent upon amended claim 3, Applicants respectfully submit that in the event that the Examiner grants entry to the foregoing Amendment, all of the claims that would remain in this application would depend either directly or indirectly from allowable Claim 3. Accordingly, Applicants respectfully submit that in the event that the Examiner grants entry to the foregoing Amendment, this application will be in condition for allowance as required by 37 CFR 1.116. Therefore, Applicants respectfully request (i) that the foregoing Amendment be granted entry, (ii) that this application be reconsidered in light of the foregoing Amendment, and (iii) that this application be allowed in response to this communication.

In the above regard, Applicants respectfully note for the record that it is still believed that the Examiner has failed to correctly understand the disclosure represented by Figs. 6-8B and 11A-13D of the present application as it applies to the presently claimed invention.

As noted previously during this prosecution, each mark 55 of the mark string 56 disclosed in the cited art is provided such that the reflectance of light differs between the mark portion 55 and the non-mark portion 58 in the recording layer 57. On the other hand, each pit 52 of the pit string 53 is formed as a hole with a constant depth (see present specification at page 5, lines 27-32). In other words, information in the so-called admitted prior art is recorded depending upon the difference in reflectance of light in the mark string 56, while information is recorded in the pit string 53 based upon the presence/absence, the length and the like of the pits that each have the same constant depth.

In other words, in the so-called admitted prior art *no information is carried by the depths of the pits of the pit string per se*, and this is true regardless of any possible presence of accidentally different depths of the mark string 56 and the pit string 53 as shown in Fig. 13B.

The present invention, on the other hand, embodies the specific goal of storing information in the depth direction of the substrate by providing pits of different depths 2a, 2b as shown in the embodiment of Fig. 1B *within the pit string itself*. Hence, Applicants respectfully submit that it heretofore was clear to anyone skilled in the art that the wording of at least Claim 2 concerning the *information recorded in the depth direction* was clear to the effect that a mark string 56 located in a depression having a different depth than that of constant depth pits of the pit string 53 does not constitute a teaching, disclosure or suggestion of the recording of information based upon differences in the depth of depressions (i.e., pits) *in addition to* the recording of information based upon the difference in reflectivity between mark and no mark areas and/or the presence/absence, length or the like of pits. Quite the contrary, Applicants respectfully submit that the idea of having the depth of pits formed in the substrate itself be a (or the) feature of the substrate that carries retrievable information is not taught, disclosed or suggested by the cited art wherein the information is carried by the presence/absence, length, width, location or reflectance of pits on the substrate.

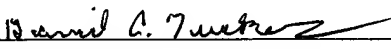
In view of the foregoing, Applicants again respectfully submit that the Examiner has read disclosure into the so-called admitted prior art that is not really present therein using a hindsight approach improperly based upon the remainder of the Applicants' disclosure, and that consequently, the Examiner's currently outstanding rejection is not supported by the present record.

Nevertheless, in the interest of advancing this prosecution and because as a practical matter more than one different pit depth is required in order to carry the information just discussed, Applicants have adopted the Examiner's suggestion concerning the combination of Claims 1-3 by the foregoing Amendment. Consequently, as mentioned above, Applicants respectfully submit that in the event that the Examiner grants entry to the foregoing Amendment, this application will be in condition for allowance without the need for further consideration and/or search by the Examiner as required by 37 CFR 1.116. Therefore, entry of the foregoing Amendment After Final Rejection Under 37 CFR 1.116, reconsideration and allowance are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: June 29, 2005

  
SIGNATURE OF PRACTITIONER

Reg. No.: 27,840  
Tel. No. (617) 517-5508

David A. Tucker  
(type or print name of practitioner)  
Attorney for Applicant(s)

Customer No.: 21874

Edwards & Angell, LLP  
P.O. Box 55874  
P.O. Address  
Boston, MA 02205